REMARKS

The Office Action dated August 26, 2008, has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. The following remarks are respectfully submitted to place the application in condition for allowance.

Claims 1, 4 - 9, 11, 12, 15, 16, 18 - 20, 22 - 27, 29, 30, 33 - 35, 37 - 39, 41 - 46, 48, 49, 51 - 53, 55 - 57, 59, 61 and 62 are currently pending in this application. Claims 1, 4, 9, 11, 15, 20, 22 - 27, 29 - 30, 33 - 35, 37 - 39, 41, 46, 48, 51, 57, and 61 have been amended. Claims 2 - 3, 10, 13 - 14, 17, 21, 28, 31 - 32, 36, 40, 47, 50, 54, 58, and 60 have been canceled without prejudice. Applicants respectfully submit that no new matter has been added by the amendments. Support for the amended claims may be found at, for example, paragraphs 0020, 0021, 0023, 0028, 0032, 0033, 0036, 0037, and 0038, and figures 4 and 5.

Applicants respectfully request reconsideration and allowance of the pending claims.

1. RESPONSE TO ARGUMENTS

In *KSR v. Teleflex*, 550 U.S. 398 (2007), the Court noted the "important[ance] [of].. identify[ing] a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does." Here, the Applicants respectfully submit that the examiner has failed to provide a reason that would have prompted one skilled in the art to combine the teachings of Dames et al., U.S. Patent Publication No. 2002/0129067 ("Dames") and Logan et al., U.S. Patent No. 6,199,076 ("Logan"), and Funk et al., U.S. Patent No. 5,937,162 ("Funk").

In particular, Logan teaches "conversion of text to speech is preferably performed at the client station by the player. In this way, text information alone may be rapidly downloaded

from the server…since it requires much less data than equivalent compressed audio files…" Logan Col. 6, ll. 25 – 33. Thus, Logan teaches away from "converting Web content from a text-based format to an audio format prior to streaming the audio format content to the user client device," as recited by the amended independent claims of the present invention. Since Logan teaches away from the independent claims, Logan cannot be effectively combined with other references to cobble together Applicants' invention.

Further, §2141.02 (VI) of the MPEP, provides that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." And §2141(X)(D)(1)-(3) provides that a "prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness…[,i]t is improper to combine references where the references teach away from their combination…[and] proceeding contrary to accepted wisdom in the art is evidence of nonobviousness." Therefore, as discussed above, Logan teaches away from "converting Web content from a text-based format to an audio format prior to streaming the audio format content to the user client device," as recited by the amended independent claims of the present invention. Thus, a combination of Dames and Logan must teach away from the claimed invention contrary to the Examiner's assertions that "there is no legal requirement that all the teachings of the secondary reference be incorporated into the primary reference." (Office Action at Page 3).

Additionally, claims 4, 11, 15, 22, 29, 33, 48, and 51 have been amended. These claims recite "a plurality of aggregated advertisements" and "retrieving additional information associated with an advertisement in response to user interaction with the advertisement, wherein the user interaction comprises recognizing a key pressed on a keypad or one or more key words

spoken by the user during delivery of an advertisement." Applicants submit that these limitations are not found in any of the cited references.

Therefore, the Applicants respectfully submit that the combination of Dames, Logan and Funk does not teach or disclose every element of the claimed invention.

2. CLAIM REJECTIONS - 35 USC §103

The burden is on the examiner to make a *prima facie* case of obviousness, which requires an objective analysis as set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). In *KSR International v. Teleflex Inc.*, 127 S.Ct 1727, 82 USPQ2d 1385 (2007), the Court affirmed that this analysis includes the following factual inquiries: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the claimed invention and the prior art; and (3) resolving the level of ordinary skill in the pertinent art. The Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 In View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* state that, having undertaken the factual inquiries of *Graham*, a rejection under 35 U.S.C. § 103 may be supported by one or more of the following rationales: (1) combining prior art elements according to known methods to yield predictable results; (2) simple substitution of one known element for another to obtain predictable results; (3) use of a known technique to improve similar devices in the same way; (4) applying a known technique to a known device ready for improvement to yield predictable results; (5) choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (6) variations that would have been predictable to one of ordinary skill in

the art; and (7) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine the prior art reference teachings to arrive at the claimed invention. 72 Fed. Reg. 57526, at 57529 (October 10, 2007). Each of the above-noted rationales requires predictability in the art and/or a reasonable expectation of success, and the examiner must consider objective evidence which rebuts such predictability and reasonable expectation of success. This objective evidence or secondary considerations may include unexpected results and/or failure of others (*e.g.*, evidence teaching away from the currently claimed invention), evidence of commercial success, and long-felt but unsolved needs, as found in the specification as-filed or other source. *Id.* When considering obviousness of a combination of known elements, the operative question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR* at 1740, 82 USPQ2d at 1396. Here, the examiner has not met this burden.

The examiner has not set forth any support under any of these rationales for the rejection under 35 U.S.C. § 103.

a) Claims 1, 4 - 9, 11, 12, 15, 16, 18 - 20, 22 - 27, 29, 30, 33 - 35, 37 - 39, 41 - 46, 48, 49, 51 - 53 and 55 are patentable under 35 USC §103 over Dames in view of Funk and further in view of Logan.

Applicants respectfully submit that the combination of Dames, Funk and Logan neither teaches nor suggests all of the elements of the claims.

With regards to independent claims 1, 9, 20, 27, 39 and 46, the Office Action suggests that "Dames does not disclose an advertisement server or inserting advertisements into the user-requested content. However, such features were well known in the art at the time of the Applicant's invention as evidenced by Funk and Logan." (Office Action at Page 8).

Funk teaches "[t]he composition processor may insert general or targeted advertisements into the electronic message. In the case of targeted advertisements, the composition processor may decide add or delete advertisements based on the customer account information or on information already assembled into the message." (Funk at Col.10 lines 47 - 53). And "[o]ptional field … contains background information about the customer such as, for example, age, annual income, and hobbies. Preferably, the background information is used to …intelligently target product advertisements to the customer." (Funk at Col.11 lines 17 - 21) .

Logan teaches an "advertisement table," (Logan Col.18, line 17), "the host server receiv[ing] and supplement[ing] the user's initial sequence of desired programs by…adding advertisements…" (Logan, Col.18 lines 21 – 26). "[S]erialization mechanism …can be used to provide a serialized advertisements to a subscriber, insuring that the subscriber does not hear a particular ad twice and further insuring that the advertisement is presented to the subscriber in the intended sequence." (Logan Col.20, lines 4 - 9). Logan also teaches that

> "All advertisements scheduled for a given subscriber may then be prioritized based on the resulting calculated weight assigned to each advertisement by matching algorithms which compare the characteristics of the subscriber with the makeup of the target audience defined by the fields of the Advertisement record. These advertisements are then preferably inserted into the programming Sequence with the advertisement having the highest weight being scheduled to occur first in the sequence, thereby insuring that the best fitting advertisements are included in the programming and most likely to be played by the subscriber...
>
> The rate at which advertising is actually inserted by the player is controlled by the ChargeLevel value in the Subscriber record for each subscriber. The ChargeLevel value (a number from 0-255) indicates the rate at which a subscriber is willing to accept advertisements. An advertisement duration count variable (not shown) maintained by the player … accumulates the total duration of actually played advertising while a program duration count variable accumulates the total duration of actually played programming. An integer division of these to duration count values indicates the proportion of time being devoted to

> advertising. If this proportion falls below a threshold value determined by the value of ChargeLevel, additional advertising is inserted between program segments until the desired proportion is again reached. In this way, advertising skipped by a subscriber will be replaced later by different advertising to yield the proper proportion of programming to advertising, thereby achieving the subscription charge rate requested by the user." (Logan Col. 26, l. 52 - Col. 27, l. 14).

Based on the above, a combination of Dames, Funk and Logan teaches inserting of general or targeted advertisements into web content, ranking the order in which advertisements are presented to the user, preventing duplication of advertisements, and ensuring that additional advertisements are presented if the advertisement duration count variable divided by the program duration count variable drops below a certain threshold.

This combination of references, however, fails to teach "means for selecting a plurality of aggregated advertisements having a format and size compatible with the user-requested Web content when the Web content is converted to an audio format for insertion within-user requested web content in response to a user request for web content" and "means for determining if a user listened to an advertisement in its entirety or the number of times a user listened to an advertisement," as recited by the independent claims of the present invention. Therefore, the combination of Dames, Funk and Logan fails to teach all of the claimed limitations of the present invention.

The Office Action suggests that "Logan expressly discloses an advertising server that host (sic) advertisements in a text-based format". (Office Action at Page 9). Logan discloses a "host server [that] … stores and maintains a plurality of data files including …advertising segments." (Logan Col. 5, ll. 47-59). Logan, however, fails to expressly disclose an advertising server as claimed by the present invention. The host server in Logan fails to teach, suggest, or

disclose the characteristics of the advertisement server recited by the independent claims because the host server does not include "means for selecting a plurality of aggregated advertisements having a format and size compatible with the user-requested Web content when the Web content is converted to an audio format for insertion within-user requested web content in response to a user request for web content" and "means for determining if a user listened to an advertisement in its entirety or the number of times a user listened to an advertisement" as required by the amended independent claims.

Therefore, the combination of Dames, Funk and Logan fails to teach all of the elements of the claimed invention.

Furthermore, the Office Action suggests that while "Funk does not expressly disclose that the insertion of the advertisements occurs before transcoding the content", "this functionality is reasonably inferred from the disclosure." (Office Action at Page 8).

In fact, Funk teaches that "if the service processing system ...provides e-mail messages to a message delivery system ... the service processing system ...can first translate the e-mail messages into the appropriate voice-mail ... format for delivery to the message delivery system ... This translation is provided by text-to-voice processor ... or facsimile processor ... respectively. Alternatively, e-mail messages may be delivered to the message delivery system ... as a conventional e-mail message, and the message delivery system ...can translate the e-mail message into the appropriate voice-mail or facsimile message format." (Funk Col. 6, ll. 13-24).

Thus, although Funk teaches multiple alternatives for converting the e-mail message from one format to another at the server, Funk fails to teach "means for inserting the retrieved advertisement within the user requested Web content" and a "means for forwarding the user requested Web content and advertisement to the text-to-speech transcoder for conversion to an

audio format and subsequent delivery to the user client device," as recited in the independent claims.

Logan also fails to teach insertion of the advertisements before transcoding the content. Logan teaches that "conversion of text to speech is preferably performed at the client station by the player. In this way, text information alone may be rapidly downloaded from the server…since it requires much less data than equivalent compressed audio files…" (Logan Col. 6, ll. 25 – 33). And "announcements … are frequently repeated in different program segments, these segments are preferably retained in local storage by the player to avoid the need to be downloaded…Announcement segments, however, are preferentially retained even though they have been played because of the higher probably they may again be included in upcoming session schedules." (Logan Col. 15, ll. 10 - 20).

Thus, Logan teaches away from the present invention which recites "converting Web content from a text-based format to an audio format prior to streaming the audio format content to the user client device" in the independent claims. In addition, as discussed above, Dames also fails to teach inserting advertisements into user requested content.

Therefore, the combination of Dames, Funk and Logan fails to teach all of the elements of the independent claims.

Additionally, the Office Action suggests that Dames "discloses retrieving content having a format and size compatible with user-requested Web content when the web content is converted to an audio format." (Office Action at Page 10). In fact, Dames teaches that the "data presentation can be customized on a template by template basis, and therefore on a document by document basis." (Dames Paragraph 40). Further, Funk teaches the end-user controlling the "format and timing of delivered emails," (Funk Abstract, Fig 8 element 808) and "selecting

timing information indicating when the electronic mailing is to be assembled and delivered..." (Funk Col. 4, ll. 17-18).

Logan teaches that

> "In order to identify and insert advertising program segments into the Schedule Table ... the preferred embodiment of the invention utilizes additional information which describes each advertisement to be placed before subscribers. This information is placed in an Advertisement record having the structure defined earlier and held in the Advertisements Table ... The ProgramID field of the Advertisement record identifies a Program_Segment record (described earlier) which describes the content of the advertisement itself. The remainder of the Advertisement record contains additional information used to control the manner in which the identified advertising program segment is selected for insertion into the programming supplied to subscribers." (Logan Col. 25, ll. 35 - 50).

Therefore, the combination of Dames with Funk and Logan fails to teach "a plurality of aggregated advertisements having a format and size compatible with the user-requested Web content when the user-requested Web content is converted to an audio format for insertion within user-requested Web content in response to a request for Web content" as recited by the independent claims.

Dependent claims 4 – 8 depend from independent claim 1, dependent claims 11 – 12, 15 – 16, 18 – 19 depend from independent claim 9, dependent claims 22 – 27, 29 – 30, 33 – 35, 37 -38, depend from independent claim 27, dependent claims 41 – 45 depend from independent claims 39, dependent claims 48 – 49, 51 – 53, 55 - 56 depend from independent claim 46. Each of the dependent claims adds further patentable features to the patentable features of the respective independent claims.

Withdrawal of the rejections and allowance of all claims are respectfully requested.

b) Claims 57 - 62 are patentable under 35 USC §103 over Wu, U.S. Patent Publication No. 2003/0212759 (hereinafter "Wu"), in view of Logan.

Regarding independent claim 57, Wu teaches that "[t]he handheld computer ... may be configured to send a notification to the advertisement server ... that the audio channel is off so that the advertisement server sends ... text advertisements instead of audio advertisements. The advertisement server ... may also send a visual warning to the user of the handheld computer ... that the audio channel is not open." (Wu Col. 7, ll. 1 - 10).

Therefore, Wu only discloses a notification being provided to the user client device in situations where the device is incapable of playing an audio advertisement rather than "notifying the advertisement server of user interaction with an advertisement" as recited by the independent claims.

Further, Logan teaches that "[t]he player mechanism ... includes both a keyboard and a microphone for accepting keyed or voice commands respectively which control the playback mechanism... the receipt of a command, which may interrupt the playback of the current selection, and the character of the command is evaluated to select one of six different types of functions." (Logan Col. 13, ll. 49 - 55).

Thus, the combination of Wu and Logan teaches, at most, sending a notification when an audio channel is unavailable for playing an audio advertisement, and using input with a keyboard or microphone to interrupt playback of content, and not "recognizing a key pressed on

a keypad or one or more key words spoken by the user during delivery of an advertisement, notifying the advertisement server of user interaction with an advertisement and retrieving additional information associated with an advertisement in response to user interaction with the advertisement" as recited in the independent claims.

Further, Wu discloses,

> "[a] method ... for providing advertising to a handheld computer operable to connect to a network. The handheld computer includes a screen for displaying visual content received from the network and is configured for playing an audio message associated with the visual content. The method generally comprises receiving a request for content from the handheld computer and associating an advertisement with the request for content. The requested content is sent to the handheld computer for display on the screen of the computer. The associated advertisement is also sent to the handheld computer for playing over an audio output device of the handheld computer." (Wu Col. 2, ll. 19 – 31).

Thus, the content sent to the user client device in Wu is a hybrid of audio and visual content, whereas the independent claims of the present invention recite "inserting the retrieved advertisements within the user requested Web content," and "forwarding the user requested Web content and advertisement to the text-to-speech transcoder for conversion to an audio format and subsequent delivery to the user client device." Therefore, the references fail to teach all the claimed limitations of the present invention.

The Office Action suggests that "Wu is silent on means for storing information associated with delivery of the advertisement to the user client device and on selecting advertisements based on subject matter of the web content." (Office Action at Page 17). The Office Action further suggests reliance on Logan to teach "(1) storing information associated

with delivery of the advertisement to the user client device and (2) selecting advertisements based on subject matter of the web content." (Office Action at Page 6).

In fact, Logan teaches that

> " Each advertising, announcement ... segment played on the player creates a UsageRecord stored as an record in the Usage Log Table having the following content: ... In the UsageRecord, the Start field contains the starting time of day (to the nearest second), the Volume field contains a value indicating the level at which the volume was played, and the PlayingSpeed field contains a value indicating the playing speed. A negative playing speed value may be used to indicate that the player was placed in the "play highlights" mode so that only highlight passages were being played...Subscriber billing is based on the accumulated amount of programming actually played by the subscriber with credit being given for advertising actually presented to the subscriber. To accomplish this, a detailed billing history can be constructed from the usage log which indicates the programs heard, the duration of each, and the cost (or credit) attributable to that program segment." (Logan Col. 27, l. 45 – Col. 28, l. 40).

Logan also teaches that

> "[a]dvertising may be associated with particular subject matter categories as well as with particular programs. For example, an airline may wish to advertise generally in connection with programming in the "travel" category whereas a particular resort hotel may wish to advertise only in connection with a particular travelogue program for the region where it is located. Subscribers may wish to hear advertising in connection with the programming in the travel category, but to eliminate commercials from a daily program presenting "today's weather report." The result is clearly advantageous for the advertiser, since advertising is focused more clearly on those having an interest in the subject matter and an expressed willingness to listen to commercial messages, while the subscriber is able to receive advertising which may be regarded as useful while eliminating unwanted advertising... Because personal data describing each subscriber's subject matter interests is available, along with personal data (age, marital status, zip code, etc.), particular advertising segments may be directed to only those subscribers having a likely interest in the goods or services advertised. This targeted advertising need not be presented at any

> time during the playback for the designated subscriber and need not be timed for presentation with particular programs. For example, a subscriber indicating an interest in travel programming may be supplied with advertising from an airline at any time, and not necessarily concurrent with selected travel programming." (Logan Col. 10, l. 55 – Col. 11, l. 15).

Thus, although Logan teaches selecting an advertisement based on a user's interests, it also teaches away from selecting an advertisement that is based on the subject matter of the programming by suggesting that a subscriber may be supplied with advertising unrelated to the current programming. In contrast, the present invention claims "selecting a plurality of aggregated advertisements having a format and size compatible with the user-requested Web content when the user-requested Web content is converted to an audio format for insertion within-user requested web content in response to a user request for web content."

In addition, Logan also teaches storing the start time for an advertisement, the playing speed and the volume at which it was played, but fails to teach "stor[ing] information associated with user interaction with the advertisement" as claimed by the present invention. Therefore, the combination of Wu with Logan fails to teach all of the claimed limitations of the present invention.

For at least these reasons, Applicants respectfully submit that independent claim 57 is allowable over the cited references. Claims 59 and 61 - 62 depend from independent claim 57 and add further patentable features to the patentable features of independent claim 57.

Withdrawal of the rejections and allowance of all claims are respectfully requested.

3. CONCLUSION

In view of the above amendments, Applicants believe the pending application is in condition for allowance. Withdrawal of the rejections and allowance of all claims are requested.

Applicants submit concurrently a request for a three-month extension of time under 37 C.F.R. § 1.136 and the accompanying fee. Please charge our Credit Card in the amount of $555 covering the fees set forth in 37 C.F.R. § 1.17(e) and 1.17(a)(3).

In the event that any additional extensions of time are necessary to prevent the abandonment of this patent application, then such extensions of time are petitioned. The U.S. Patent and Trademark Office is authorized to charge any additional fees that may be required in conjunction with this submission to Deposit Account Number 50-2228, under Order No. 026624.0224PTUS, from which the undersigned is authorized to draw.

Dated: February 26, 2009

Respectfully submitted,

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